

#61128
PATENTCustomer No. 22,852
Attorney Docket No. 7040.0086.00

10/21/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Renato CARETTA)
Application Serial No. 09/842,662)
Filed: April 27, 2001)
For: CARCASS STRUCTURE FOR)
VEHICLE-WHEEL TYRES AND)
ITS METHOD OF)
MANUFACTURING)

Group Art Unit: 1733

RECEIVED

OCT 17 2003

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Examiner: Knable, G.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Applicant submits this Response to Restriction Requirement, accompanied by a Supplemental Preliminary Amendment, in reply to the Office Action mailed September 11, 2003, the period for response to which runs through October 14, 2003 (October 11, 2003, is a Saturday; October 12, 2003, is a Sunday; and October 13, 2003, is a Federal holiday).

Applicant also submits a Supplemental Information Disclosure Statement Under 37 C.F.R. § 1.97(b); a copy of Receipt Card stamped on April 27, 2001; a copy of a Preliminary Amendment filed April 27, 2001 ("Preliminary Amendment"); and a copy of an Appendix to Preliminary Amendment Dated April 27, 2001 ("Appendix").

Originally-Filed Papers

As demonstrated by the copy of the stamped Receipt Card, the originally-filed papers for the present application included the Preliminary Amendment and the Appendix. The

FINNEGAN
HENDERSON
FARABOW
GARETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Preliminary Amendment added, inter alia, new claims 30-58. Thus, prior to entry of the Supplemental Preliminary Amendment, the pending claims in the present application include claims 1-58.

Additionally, both the Filing Receipt mailed June 25, 2001, and the Updated Filing Receipt mailed September 28, 2001, indicate that the present application includes 58 total claims.

Telephone Conference With Examiner

During a telephone conference with the Examiner on October 1, 2003, the undersigned Applicant's representative pointed out the Office Action incorrectly limited the pending claims to claims 1-29. The Examiner indicated that because claims 30-58 include claims directed to a carcass structure and a method for manufacturing the carcass structure (similar to claims 1-29), the restriction requirement could be read as requiring restriction to Group I, claims 1-16 and 30-45, and Group II, claims 17-29 and 46-58. This Response to Restriction Requirement proceeds on that basis.

Restriction Requirement

In the Office Action, the Examiner required restriction under 35 U.S.C. § 121 between: Group I, claims 1-16 and 30-45, characterized by the Examiner as drawn to a carcass structure; and Group II, claims 17-29 and 46-58, characterized by the Examiner as drawn to a method to manufacture a carcass structure. The Supplemental Preliminary Amendment cancels, without prejudice or disclaimer, claims 1-58, and adds new claims 59-116. New claims 59-74 and 88-103 correspond to Group I (reciting a tyre for a vehicle wheel), and new claims 75-87 and 104-116 correspond to Group II (reciting a method of manufacturing a tyre for a vehicle wheel).

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HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Applicant provisionally elects, with traverse, to prosecute Group I, new claims 59-74 and 88-103.

Regarding traverse of the restriction requirement, Applicant submits that the search and examination of this entire application can be made without serious burden. As such, MPEP § 803, ¶ 2, requires that the Examiner examine this entire application on the merits.

Election of Species Requirement

In the Office Action, the Examiner also required an election of species under 35 U.S.C. § 121 between: proposed Species A, characterized by the Examiner as drawn to the embodiment illustrated in Figs. 11-14; proposed Species B, characterized by the Examiner as drawn to the embodiment illustrated in Fig. 15; and proposed Species C, characterized by the Examiner as drawn to the embodiment illustrated in Fig. 16. Applicant provisionally elects, with traverse, to prosecute proposed species A. At least the following claims read on this provisional election: claims 61-64 and 90-93.

Regarding traverse of the election of species requirement, Applicant submits that at least independent claims 59, 75, 88, and 104 are generic to all of the proposed species as characterized by the Examiner. Thus, if these or other generic claims are found to be allowable, Applicant submits that Applicant is entitled to consideration of all claims dependent from the allowed generic claims and all claims that include all the limitations of any of the allowed generic claims.

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HENDERSON
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DUNNER LLP

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Washington, DC 20005
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Response to Restriction Requirement—Filed October 14, 2003

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Dated: October 14, 2003

By: _____

Lawrence F. Galvin
Reg. No. 44,694

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com